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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,901	07/10/2001	Nicholas Luke Bennett	007051.P007	9644

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Stephen M. De Klerk
Blakely, Sokoloff, Taylor, & Zafman LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER	
HSU, RYAN	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/902,901	BENNETT ET AL.	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-17 and 21-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2-17,21-38,40,42-53 and 55* is/are allowed.

6)☒ Claim(s) *39,41,54 and 56-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 3/20/06, claims 2, 5, 12-18, 26-28, 34-40, 45-47, 49-52, 55 and 61 have been amended. Claims 1 and 18-20 have been canceled without prejudice and claims 2-17, and 21-61 are pending in the current application.

Claim Objections

Claim 27 is objected to because of the following informalities: the current claim limitation reads "wherein the target is railway skip car" the examiner suggest in order to clarify the intent of the claim to be "wherein the target is a railway skip car". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "chocolate wheel" in claims 39 and 41 is used by the claim as interpreted by the examiner to mean a basic wheel (*ie: a common element in bonus game machines*) however, the specification fails to clearly define what is meant by a "chocolate wheel". The specification does not describe how and why the applicant incorporates a chocolate wheel or exactly what a chocolate wheel is.

It is simply used as a term as if it is an understood term in the gaming arts and what it can be used for in the instant invention. From what can be deciphered by the examiner, as shown through the drawings, a "chocolate wheel" is a term that can be any type of spinning wheel and therefore would be a common element found in many modern gaming machines. However, the term "chocolate wheel" as defined in common terms renders this language indefinite as no support in the specification is found to clarify the issue addressed below. On one hand a chocolate wheel can be referred to a common wheel element that is simply made through design choice to have a "chocolate" color or in the alternative it can be used to describe the actual material in which the wheel is made out of. Since both of these interpretations of the term "chocolate wheel" are reasonable to one of ordinary skill in the art the term is indefinite because the specification does not clearly redefine the term and enable the invention to define the term "chocolate wheel".

Claims 54 and 56-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation appears "wherein the bonus condition causes a change in the game structure for future games". The specification lacks support for this limitation as it is not described or enabled how a bonus condition affects the game structure of future games. The specification is only directed towards a bonus condition awarding a bonus prize or reward to the user of the game console and does not discuss the structure of future games.

Allowable Subject Matter

Claims 2-16, 21-26, 28-38, 40, 42-53, 55, and 61 are allowed.

Claims 2-16, 21-38, 40, 42-53, 55 and 61. With respect to the limitations of claim 21, the prior art does not teach or suggest a gaming device including a hybrid pachinko game wherein the number and position of the prize zones are selected as a result of the size of a bet wagered by the player on the particular game. Thus claim 21 is allowable. Claims 2-16, 22-38, 40, 42-53, 55, and 61 inherit allowability from claim 21.

The following is an examiner's statement of reasons for allowance:

Claim 21 is directed towards an electronic gaming console that incorporates a hybrid game so that two different sub-games may be played simultaneously. Where one game includes rotatable reels of a spinning reel game and the second comprises of a labyrinth of pins or pins and holes of a pin and ball game, otherwise known as a pachinko game. The instant invention also awards the user a prize based upon the combined outcome of the reel game and the pin and ball game to define a winning combination. The gaming console also incorporates a number of prize zones each offering a bonus feature or prize wherein the number and position of the prize zones is variable from game to game and the number and position of the prize zones is selectable by a player. Furthermore, the claims are directed towards the number and position of the prize zones to be selected as a result of the size of a bet wagered by the player on the particular game.

The closest prior art of record, Ugawa discloses a hybrid reel game and pachinko game. Ugawa discloses the games to be played simultaneously and reward a player when a winning combination that is the combination of the reel game outcome and pachinko game outcome. However, the prior art of record does not fairly teach or disclose the number of prize zones to be

selected as a result of the size of the bet wagered by the player on the particular game. This enhancement or feature in the game provides an increased player excitement which was not taught in the prior art of hybrid reel and pachinko games, as a result this variation improves on the hybrid game by encourages players to wager more money and thereby increasing the revenue of the gaming console.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 39, 41, 54, and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa (US 5,836,819) and further in view of Adams (US 5,882,261).

Ugawa discloses a hybrid game device offering a slot-type game and a pachinko type game wherein the prizes from each game are combined to produce an award. The particular features of the listed claims are discussed below.

With regard to claims 39, 41, 54 and 56-57, Ugawa discloses an electronic gaming console having credit means, reward means, game control means, display means, and player input controls, the control means being responsive to the credit means and the player input

controls to play a game which is displayed on the display means and if a winning event occurs, a player reward is awarded by the reward means, the gaming console being characterized in that the game provides a video display, for displaying a game image of a hybrid game comprising two different sub-games played simultaneously wherein:

a first sub-game providing a game imaged displayed the video display, the game image comprising one or more rotatable reels of a spinning reel game;

a second sub-game providing a game image displayed on the video display, the game image comprising a labyrinth of pins or pins and holes of pin and ball game;

player input controls allowing the player to initiate the motion of the one or more rotatable reels of the first sub-game and one or more ball images on the display of the second sub-game; player rewards being awarded when the reel and ball images come to rest in predetermined prize winning locations;

the spinning reel and pin and ball sub-games each potentially contributing to a single game outcome which depends on outcomes of each of the sub-games and player rewards as a result of the combined game outcome are awarded as a result of events in the sub-games or combination of those events; game outcomes that result in a player award comprising a combination of a first event in the first sub-game and a second event in a second sub-game (*see Fig. 1-3, 55B; col. 33: ln 62- col. 34: ln 12*);

at least one of the game outcomes being the award of a feature outcome, the feature outcome being the awarding of either a feature event or feature game or the awarding of a jackpot prize, the feature outcome being awarded when the reel game outcome and the pin and ball game outcome, when combined, together define a winning combination (*See fig. 56A, 56 B*

[S51-60] and the related description thereof, col. 5: ln 65-col. 7: ln 65). Ugawa effectively discloses a system wherein the slot game and the bonus pachinko (*ie: pin and ball*) game help in determining a winning combination. Furthermore, the base slot game of Ugawa has a set of predetermined game outcomes serve as an award for a play in the pachinko game.

Additionally, Ugawa teaches a further type of game is incorporated into the base game. The base game device incorporates two games: a slot game and a pachinko game. Furthermore, the game is provided as a feature game associated with the (*See fig. 1-3*) base game (*See* id). Both the slot game and pachinko games constitute "feature" games. Ugawa also teaches a game wherein the bonus condition is the game structure for future games as in once a bonus feature is reached the jackpot is reset or the symbols and indicia are associated with certain containers and therefore these things all affect the structure for future games (*see Figs. 15-21(a-b) and the related description thereof*). However, Ugawa is silent with respect to a feature game where a chocolate wheel that replaces a prize container such that where as a ball drops through the chocolate wheel, it will spin and pay the prize that is spun up.

Ugawa does not disclose the feature of a wheel activated by a ball or other means to provide a multiplier, bonus or trigger determined by the stopping position of the wheel.

In a related gaming machine patent, Adams teaches an analogous game device having a slot game and pachinko game in which a wheel is activated to provide a multiplier (*See abstract*) *1: ln 58- col. 2: ln 13*). In view of Adams, it would have been obvious to an artisan to modify the game device described by Ugawa to add the features of a wheel activated by a ball or other means to provide a multiplier, bonus or trigger determined by the stopping position of the wheel.

As suggested by Adams, the modifications would make the game more appealing to players by providing them additional opportunities for winning payouts (*see col. 1: ln 58-col. 2: ln 13*).

Adams also teaches that the wheel is divided into a plurality of wheel segments with one symbol or prize indicia indicated or displayed in each segment (*See col. 1: ln 58-col. 2: ln 13*). Although both Ugawa and Adams both lack in teaching or suggesting a "chocolate wheel". However, the color or material made of the wheel does overcome the prior art as it would be expected of the wheel of the prior art of Adams to perform equally well without an unexpected result as that of the instant invention without needing to be the color "chocolate" or made from "chocolate". Therefore it would have been an obvious matter of design choice to make the wheel taught in Adams either a chocolate color or out of chocolate to one of routine skill in the art at the time the invention was made.

Claims 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa in view of Adams, as applied to claim 56 above, in further view of Bennett (U.S. 5,085,436 (Feb. 4, 1992)).

Claim 58. The game device suggested by Ugawa in view of Adams does not disclose new prize indicia selected and displayed on the respective wheel segments at the commencement of each main game. Regardless, Bennett discloses an analogous game device in which new prize indicia are selected and displayed on reel segments at the commencement of each game (*See fig. 2-8, col. 1: ln 5-15*). Reels are equivalent to wheels because both are spinning indicators used to generate random outcomes for game devices. Reels differ only in that

they display indicia on their edge rather than their face. Thus, in view of Bennett, it would have been obvious to an artisan at the time of the invention to modify the game device suggested by Ugawa in view of Adams, wherein outcomes are generated on a wheel, to add the feature of selecting and displaying new prize indicia on the respective wheel segments at the commencement of each main game. As suggested by Bennett, changing indicia allows a game device to offer larger awards by controlling the probabilities without changing the size of the wheel in order to make the device more attractive to potential players.

Claims 59 an 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa in view of Adams, as applied to claim 56 above, in further view of Heinen et al. (DE 3638100 A (May 11, 1998)).

Claim 59. The game device suggested by Ugawa in view of Adams does not disclose a central portion of a wheel which carries symbols and indicators around the periphery of the wheel indicate rotation and a final stopping position. Regardless, Heinen discloses a game device having an analogous wheel in which central portion of a wheel which carries symbols and indicators around the periphery of the wheel indicate rotation and a final stopping position (*See abstract*). The wheel disclosed by Heinen is recognized in the art as substitute for the wheel disclosed for the same purpose of indicating random game outcomes. Thus, in view of Heinen, it would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to modify the game device suggested by Ugawa in view of Adams, wherein a spinning

wheel indicates game outcomes, to substitute the wheel disclosed by Heinen to indicate game outcome.

Claim 60. Heinen discloses a series of visual lights are provided around the wheel image such that rotation is indicated by lighting the lights in sequence such that the illuminated lights change in a rotating pattern, and after rotation of the pattern stops, a light is left illuminated adjacent to one wheel segment to indicate the prize indicia or symbol carried on that segment as the selected symbol or prize (*See abstract*).

Response to Arguments

Applicant's arguments filed 3/20/06 have been fully considered but they are not persuasive. Although claims 41 and 54 had previously been indicated as allowable subject matter the Examiner has noticed several U.S.C. 112 issues with the limitations of the claims as stated in the preceding sections of this office action. In addition, the indefinite language and lack of enablement have allowed the Examiner to apply the art rejection above. Therefore the reasons for allowance with respect to the office action sent 11/17/2005 has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

April 11, 2007

SCOTT JONES
PRIMARY EXAMINER